

REMARKS/ARGUMENTS

The claims have been divided into Groups as follows:

- Group I: Claims 1-6 and 18-20, drawn to a carbon nanotube dispersed composite material.
- Group II: Claims 7 and 15, drawn to a first method of making a carbon nanotube dispersed composite material.
- Group III: Claim 8, drawn to a second different method of making a carbon nanotube dispersed composite material.
- Group IV: Claim 9, drawn to a third different method of making a carbon nanotube dispersed composite material.
- Group V: Claim 10, drawn to a fourth different method of making a carbon nanotube dispersed composite material.
- Group VI: Claim 11, drawn to a fifth different method of making a carbon nanotube dispersed composite material.
- Group VII: Claim 12, drawn to a sixth different method of making a carbon nanotube dispersed composite material.
- Group VIII: Claim 13, drawn to a seventh different method of making a carbon nanotube dispersed composite material.
- Group IX: Claim 14, drawn to an eighth different method of making a carbon nanotube dispersed composite material.
- Group X: Claims 16-17, drawn to a heat exchanger comprising carbon nanotubes.

Applicants elect, with traverse, Group II, Claims 7 and 15 (drawn to a first method of making a carbon nontube dispersed composite material), for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Examiner has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups I - X do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

“Claim 1 is obvious over JP 10168502 (JP ‘502) in view of JP 2000-128648 (JP ‘648). JP 502 teaches a composite material comprising (1) carbon nanotubes and (2) a metal powder and as is shown in claim 15, this mixture is sintered. Although the discharge plasma sintering aspect is not literally defined, this would be obvious since the hot pressing is performed from 20-1500°C. At the time of invention, it would be obvious to a person of ordinary skill to synthesize the carbon nanotube composite material (JP ‘502) utilizing the discharge plasma (JP ‘648). The suggestion or motivation for doing so would have been to make a homogenous compact body that has low defect.

Accordingly the special technical feature linking all groups (i.e. the composition of claim 1) does not provide a contribution over the prior art, thus no single general inventive concept exists and restriction is appropriate.”

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided any indication that the contents of the claims *interpreted in light of the description* was considered in making the assertion of a lack of unity and therefore has not met the burden necessary to support the assertion.

Furthermore, 37 C.F.R. § 1.475(b) states in pertinent part:

“An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; . . .”

In addition, The MPEP §806.03 states:

“Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are not directed to distinct inventions; rather they are different definitions of the same disclosed subject matter, varying in breadth or scope of definition.”

Applicants respectfully submit that the Office has not considered the relationship of the inventions of Groups I-X with respect to 37 C.F.R. § 1.475(b)(3) [product = claims 1-6 and 18-

20; process = claims 7-15; use = claims 16 and 17] and MPEP §806.03. Therefore the burden necessary according to MPEP § 1893.03(d) to sustain the conclusion that the groups lack of unity of invention has not been met.

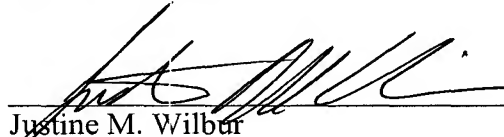
Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction.

Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

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